REMARKS

Claims 1-7, 12-23, and 28-32 are pending in the case. The Examiner rejected claims 1-2, 13-14, 17-18, and 29-32 under 35 U.S.C. §102(b) as being unpatentable in view of U.S. Patent No. 6,401,118 to Thomas (hereinafter "Thomas"). The Examiner rejected claims 3, 15, and 19 under 35 U.S.C. §103(a) as being unpatentable in view of Thomas and U.S. Patent No. 5,675,819 to Schuetze (hereinafter "Schuetze"). The Examiner rejected claims 4-7, 16, 20-23, and the various multiple dependent combinations under 35 U.S.C. §103(a) in view of Thomas and U.S. Patent Publication No. 2002/0156763 to Marchisio (hereinafter "Marchisio"). The Examiner rejected claims 12 and 28 under 35 U.S.C. §103(a) as being unpatentable in view of Thomas and U.S. Patent No. 6,014,664 to Fagin et al. (hereinafter "Fagin"). The Examiner rejected claims 1/2/3/6, 17/18/19/22, 1/2/3/6/7 and 17/18/19/22/23 under 35 U.S.C. §103(a) in view of Thomas, Schuetze, and Marchisio.

Applicant has amended Claims 1, 2, 7, 13, 14, 17, 18, 29, and 31 to clarify the invention. Applicant respectfully asserts that the pending claims are in condition for allowance. Applicant respectfully requests the prompt allowance of Claims 1-7, 12-23, and 28-32.

REJECTION OF CLAIMS 1-2, 13-14, 17-18, AND 29-32 UNDER 35 U.S.C. §102(b)

The Examiner rejected claims 1-2, 13-14, 17-18, and 29-32 under 35 USC §102(b) in view of Thomas. Applicant has amended claims 1-2, 13, 17, 18, 29, and 31. Specifically, Applicant has clarified the gathering of user feedback from a user through weighting of the context information. Support for these amendments is found in the Specification on page 8 lines 1-14. The user reviews the context information and weights the search results based on the context information the user is interested in. Then, the results are ranked using a rank criterion comprised of this weighting. Applicant respectfully submits that this element of weighting of context information is not taught or suggested by the prior art of record. Therefore, these amended claims as well as all dependent claims are allowable over the rejection under 35 U.S.C. §102(b).

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Thomas teaches a web based software application that searches the Internet for web pages and other internet sites that may potentially contain infringing intellectual property. *See* Thomas Abstract. Thomas downloads the pages or files that are located based on search criteria provided by a user. Thomas then automatically scores, or ranks, the pages and files using predefined conditions. *See* Thomas Col. 9, lines 8-30. The pages are not scored or ranked based on any user input. Thomas also teaches prioritizing of sites or web pages. *See* Thomas Col. 10, lines 55-65. The prioritizing of sites or web pages is performed by users reviewing the set of URL's previously collected. *See* Thomas Col. 11, lines 2-5. Thomas indicates the benefit of user review. *Id.*

The Applicant has recognized a problem with this approach. Specifically, Thomas requires the users to review the content of the results, the URL or the web page or file associated with the URL. This is very time consuming. Users may waste large amounts of time reviewing irrelevant content.

In contrast, as recited in the independent claims, Claim 1, 13, and 17. The present invention employs users to review and provide feedback regarding the context information not the content of the files retrieved. *See* Specification page 8, lines 1-14. Applicant respectfully asserts that this distinction is significant as reviewing a few terms that make up context information saves significant time over opening and reviewing each document retrieved.

It is well settled that under 35 U.S.C. §102 "an invention is anticipated if . . . all the claim limitations [are] shown in a single art prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim." Richardson v. Suzuki Motor Co., Ltd., 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 is representative of the independent Claims 13 and 17. Claim 1, as amended, recites "weighting of the presented context information by the user through user input." Claim 1 further indicates that the results are ranked based at least in part on the user-weighted context information." Applicant finds no suggestion or teaching in Thomas of "weighting of...context information." The context information is information gathered from the documents in the result set. *See* Specification page 7, lines 25-26. Thomas does seem to teach ranking or scoring of

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results but not weighting of context information. *See* Thomas Col. 9, lines 8-30.

Claim 2 recites "...revising the <u>weighting of the user-weighted context information.</u>" Thus, Claim 2 includes the same subject matter, weighting of user-weighted context information. Therefore, Claim 2 is allowable for the same reasons as Claim 1. By weighting context information, the present invention saves the user time because the results need not be reviewed individually. The user can rely on the context information instead and can weight the context information according to the context the user intended when the original search criteria was provided.

Prior to the amendment of Claim 1, the Examiner relied on Col. 6, lines 33-34 in support of gathering of at least one rank criterion from the user. However, Applicant respectfully notes that Thomas teaches definition of search criteria by a user not definition of rank criterion. Applicant submits that search criteria is very different from rank criterion. Search criteria is used as criteria for identifying records or files having characteristics that satisfy the search criteria. Rank criterion is criteria used for ordering a set of results, such as records or files. These two types of criteria are very different.

Claims 13 and 17, as amended, include substantially the same subject matter as discussed above in relation to Claim 1. Claims 14, 18, and 29-32 depend on Claims 1, 13, and 17. Therefore, Applicant respectfully submits that these amended claims, as well as all dependent claims are patentable over Thomas under 35 U.S.C. §102(b).

REJECTION OF CLAIMS 3-7, 12, 15, 16, 19, 20-23, and 28 UNDER 35 U.S.C. §103(a)

The Examiner rejected claims 3-7, 12, 15, 16, 19, 20-23, and 28 under 35 U.S.C. §103(a) in view of Thomas, Schuetze, Marchisio, and Fagin. Applicant respectfully traverses this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *See* MPEP § 2142. To establish a *prima facie* case of obviousness, the combination of the prior art references must teach or suggest all the claim limitations. *See id.* Furthermore, even if all the claim limitations are taught or suggested, there must be some suggestion or motivation to combine reference teachings. *See* MPEP §2142. Applicant respectfully asserts that a *prima facie*

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case of obviousness has not been made because not all the elements recited in the claims are taught or suggested by the prior art and there is no teaching or suggestion in the art to combine the references to produce the claimed invention.

Applicant respectfully asserts that Thomas, Schuetze, Marchisio, and Fagin fail to teach or suggest all the claim limitations of the amended independent claims 1, 13, and 17. Specifically, the references fail to teach or disclose "weighting of the presented context information by the user through user input" or ranking of the documents based at least in part on the user-weighted context information." The references fail to teach or disclose involving a user in the weighting of context information of documents in a result set.

The Examiner relies heavily on Thomas to reject independent claims 1, 13, and 17 under 35 U.S.C §102(b) and then relies on this argument to reject claims 3-7, 12, 15, 16, 19, 20-23 and 28. However, neither Schuetze, Marchisio, nor Fagin include teachings of weighting of context information by a user.

As discussed above, Thomas teaches user review of results, the URLs and/or files not user weighting of context information. In weighting the context information, a user is assigning a level of importance to the context information that was gathered from the document. See Specification page 8, lines 1-7. Applicant finds no such weighting performed by a user in Thomas, Schuetze, Marchisio or Fagin.

Finally, even if all the claim limitations are taught or suggested, there must be some suggestion or motivation to combine reference teachings. *See* MPEP § 2142. This suggestion or motivation to combine references must be established by factual findings. "The factual inquiry whether to combine references must be thorough and searching. (quoting *McGinley v. Franklin Sports, Inc.* 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)).

Applicant asserts that because the Examiner has not provided evidence of teachings or suggestions of weighting of context information by a user using user input and re-rank the documents based on a revised weighting, the Examiner has also failed to provide evidence why one of skill in the art would select the prior art references or combine them. Therefore, this further supports Applicant's assertion that claims 3-7, 12, 15, 16, 19, 20-23, and 28 are allowable 35 U.S.C. §103(a) over the prior art of record.

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Because Thomas, Schuetze, Marchisio and Fagin fail to provide any teaching or suggestion of the element of "weighting of the presented context information by the user through user input" or ranking of the documents based at least in part on the user-weighted context information," Applicant respectfully asserts that claims 3-7, 12, 15, 16, 19, 20-23, and 28 are allowable.

In view of the foregoing, Applicant submits that the application is in condition for immediate allowance. In the event any questions or issues remain that can be resolved with a phone call, the Examiner is respectfully requested to initiate a telephone conference with the undersigned.

Respectfully submitted,

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